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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/529,126	12/19/2005	Michael Robert Stott	KILBU P-76/500728.20085	1868
26418 7590 12/18/2008 REED SMITH, LLP ATTN: PATENT RECORDS DEPARTMENT 599 LEXINGTON AVENUE, 29TH FLOOR NEW YORK, NY 10022-7650			EXAMINER COLEMAN, KEITH A	
			ART UNIT 3747	PAPER NUMBER
			MAIL DATE 12/18/2008	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/529,126	Applicant(s) STOTT ET AL.	
	Examiner KEITH COLEMAN	Art Unit 3747	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 October 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4 and 8-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4 and 8-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, the limitations of “of which” does not clearly point out the preceding aspects of the claimed subject such as the rotary shaft, the flange, circular section, and etc. Applicant is reminded to See MPEP 2111. In re Prater, 415 F.2d 1393, 1404-05, 162 USPQ 541, 550-51 (CCPA 1969) The court explained that “reading a claim in light of the specification, to thereby interpret limitations explicitly recited in the claim, is a quite different thing from ‘reading limitations of the specification into a claim,’ to thereby narrow the scope of the claim by implicitly adding disclosed limitations which have no express basis in the claim.” To further prosecution, the “of which” limitation is regarded as the rotary shaft.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 1 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

In claim 1, the limitation of “the radially inner and radially outer surfaces of the cavity facing the radially inner and radially outer surfaces, respectively, of the inertia mass” is at odds with Applicant’s Specification. As written and considering the proper use of ‘respectively’, the cavity’s inner surface would face the mass’s inner surface and the cavity’s outer surface would face the mass’s outer surface. As best understood, this arrangement would require the surfaces to be one of the same. If there is support in Specification, Examiner respectfully asks Applicant to highlight this arrangement. To further prosecution, the cavity is in contact with the mass.

As to the new limitations of “the inertia mass and the cavity having relative dimensions to allow the inertia mass limited movement in rotation with respect to the cavity,” it was not examined on the merits.

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The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-4 and 8-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Robbins et al. (US Patent No. 6,190,137).

With regards to claim 1, the patent to Robbins et al. discloses all the limitations of the claimed subject matter including a rotary shaft (i.e. crankshaft 40, Col. 3, Lines 34-38, See Figure 1) for rotation about an axis and carrying an eccentric, substantially circular section (112), radially extending flange (112, Col. 3, Lines 49-51, See Figure 3), connected to the radially extending outer surface the flange is an annular housing (64) affording a cavity (i.e. the interior space of 124, See Figure 3D and Col. 5, Lines 26-30) defined in part by radially inner and radially outer coaxial cylindrical surfaces of the annular housing (64, See Figure 3D), the axis (120, Col. 5, Lines 60-65) of which is offset from the axis of the shaft (104, Col. 6, Lines 10-15, See Figure 3C), the cavity accommodating an annular inertia mass (116, See Figure 5, Col. 7, Lines 35-40), the inner and outer surfaces of the cavity (i.e. the interior space of 124, See Figure 3D and Col. 5, Lines 26-30) being in contact with the inertia mass (116), whereby there are two pairs of opposed surfaces (See Figure 5), one of the said pairs constituting bearing surfaces guiding relative rotation of the inertia mass (116) and the housing (124) about the axis of the coaxial cylindrical surfaces (See Figure 5), the other of the said pairs being spaced apart to define an annular space (142) accommodating a displaceable material (142), the inertia mass (116) and the cavity (124) having a dimension in the radial direction which has a maximum value at a first position opposite to the direction of eccentricity and decreases progressively in both circumferential directions to a second position offset by angle from the first position (via 138, See Col. 7, Lines 45-65 and Col. 8, Lines 25-35), except positively disclosing the offset being 180 degrees.

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It would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the angular displacement of the inertia mass of Robbins et al. with a 180 degrees offset, because the modification is invariably a change in dimension. See MPEP 2144.04. In *Gardner v. TEC Systems, Inc.*, 725 F.2d 1338, 220 USPQ 777 (Fed. CIR. 1984), cert. Denied, 469 U.S. 830, 225 USPQ 232 (1984), the Federal Circuit held that, where the only difference between the prior art and the claims was a recitation of relative dimensions of the claimed device and a device having the claimed relative dimensions would not perform differently than the prior art device, the claimed device was not patentably distinct from the prior art device.

With regards to claim 2, the patent to Robbins et al. discloses the displaceable material is a viscous liquid (i.e. oil, Col. 4, Lines 40-45).

With regards to claim 3, the patent to Robbins et al. discloses the viscous liquid comprises a grease (i.e. oil, Col. 4, Lines 40-45).

With regards to claim 4, the patent to Robbins et al. discloses the housing (i.e. interior cavity of 124) is closed by a cover plate (i.e. surface of 124) extending in a radial plane.

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With regards to claims 8-11, the patent to Robbins et al. discloses spring means (spring 140 via 138) acting on the inertia mass (116) and biasing it towards a position in which the radial width of the space is constant.

With regards to claim 12-19, the patent to Robbins et al. discloses wherein the thickness in the axial direction of the portion of the housing (i.e. interior surface of 124) opposite to the direction of eccentricity is greater than that of the eccentric flange (See Figures 1-5).

Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over Robbins et al. (US Patent No. 6,190,137) in view of

With regards to claim 20, the patent to Robbins et al. discloses all the limitations of the claimed subject matter including a rotary shaft (40) for rotation about an axis and carrying at least one pair of axially spaced, radially extending eccentric crankwebs (i.e. 116), at least one of which has a circular cylindrical radially outer surface, the axis of which is offset from the axis of the crankshaft (40) and connected to which is the inner surface of an annular member of resilient material (i.e. steel, Col. 4, Lines 60-65), connected to the outer surface of which is the cylindrical inner surface of an annular inertia mass, the weight distribution of which counterbalances the eccentricity of the

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associated crankweb (116, See Figures 1-5), except positively disclosing an elastomeric material.

The patent to Hinderks discloses an elastomeric material (See Figure 121, Col. 37, Lines 5-20 and 50-68).

Since Hinderks explicitly states in Col. 37, Lines 50-68 that “In FIG. 123, one track ensures that about the apex of reciprocation a minimum designed compression ratio is reached, while in that region the second track grows more distant from the first, to enable a moving component (**such as piston/rod assembly 3004**) under certain conditions to travel beyond its designed compression ratio,” it would have been obvious to a person of ordinary skill in the art at the time the invention was made to substitute the material of Robbins et al. with an elastomeric material in view of the teaching to Hinderks, in order to absorb load caused by deformation (Col. 37, Lines 30-35 from Hinderks) and the modification is invariably a change in material. See MPEP 2144.07. *In re Leshin*, 227 F.2d 197, 125 USPQ 416 (CCPA 1960) (selection of a known plastic to make a container of a type made of plastics prior to the invention was held to be obvious);

As to the limitation of “automotive crankshaft”, Applicant is reminded to See MPEP 2111.02, Section II. *Pitney Bowes, Inc. v. Hewlett-Packard Co.*, 182 F.3d 1298, 1305, 51 USPQ2d 1161, 1165 (Fed. Cir. 1999). See also *Rowe v. Dror*, 112 F.3d 473, 478, 42 USPQ2d 1550, 1553 (Fed. Cir. 1997) (“where a patentee defines a structurally complete invention in the claim body and uses the preamble only to state a purpose or intended use for the invention, the preamble is not a claim limitation”);

Response to Arguments

Applicant's arguments filed 10/9/2008 have been fully considered but they are not persuasive.

Applicant's Arguments

Applicant has amended the claim language to replace oppose to facing. In addition, Applicant further contends that Robbins et al. does not disclose a rotary shaft nor discloses an annular space accommodating a displaceable material. Lastly, Applicant has amended claim 20 to further include an elastomeric material.

Examiner's Response to Arguments

As mentioned before and considering the proper use of respectively, the inner surface of the housing would face the inner surface of inertia mass and outer surface would face the outer surface. The reification of this concept can't exist unless the surfaces are one of the same. As such, the 112 rejection still holds.

As to Applicant's second argument, a rotary shaft is clearly defined as "a rotating or oscillating round, straight bar for transmitting motion and torque" and ostensibly, Robbins discloses a rotary shaft in Figure 1.

Lastly, the patent to Hinderks discloses an elastomeric material (3096, Col. 37, Lines 30-35)

In closing, the specificity found in Applicant's remarks and specification is not found in the claim language. Applicant is reminded to see MPEP 2111. In re Prater, 415 F.2d 1393, 1404-05, 162 USPQ 541, 550-51 (CCPA 1969) The court explained that "reading a claim in light of the specification, to thereby interpret limitations explicitly recited in the claim, is a quite different thing from 'reading limitations of the specification into a claim,' to thereby narrow the scope of the claim by implicitly adding disclosed limitations which have no express basis in the claim." Thus, the claim is not limited to such interpretation and the rejection still holds.

As such, this action is made final.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to KEITH COLEMAN whose telephone number is (571)270-3516. The examiner can normally be reached on 5:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen Cronin can be reached on (571)272-4536. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

KAC
/K. C./
Examiner, Art Unit 3747

/Stephen K. Cronin/
Supervisory Patent Examiner, Art Unit 3747